

REMARKS

This paper is submitted in response to the Office Action dated March 2, 2005. A request for a one month extension of time has been submitted concurrently herewith. Therefore, the period of response extends up to and includes July 5, 2005 (since July 2, 2005 is a Saturday and July 4, 2005 is a holiday). Authorization to charge the requisite fee of \$120.00 to Deposit Account 23-3000 for the extension is hereby granted. Reconsideration and allowance of all pending claims by the Examiner are respectfully requested.

In the subject Office Action, claims 61-72 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In addition, claims 38-47, 50-57, 60-70 and 73-75 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,675,507 to Bobo II. Furthermore, claims 48-49, 58-59 and 71-72 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bobo II in view of U.S. Patent No. 5,996,007 to Klug et al.

Applicants respectfully traverse the Examiner's rejections to the extent that they are maintained. Applicants have canceled claims 63 and 64 and amended claim 61. Applicants respectfully submit that no new matter is being added by the above amendments, as the amendments are fully supported in the specification, drawings and claims as originally filed.

Now turning to the subject Office Action, and more particularly to the §101 rejections, the Examiner will note that claim 61 has been amended to clarify the recited program is tangibly embodied on a computer readable medium, per the Examiner's suggestion. Claims 63 and 64 have also been canceled for consistency with the amendment to claim 61. While Applicants maintain a traversal of the Examiner's rejection, Applicants submit that the subject amendments adequately address the Examiner's concerns. Reconsideration and withdrawal of the §101 rejection are therefore respectfully requested.

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Next, turning to the art-based rejections, the Examiner has now issued what is by Applicants' account the fifth separate rejection of the pending claims as they stand in their present form. Moreover, this rejection is subsequent to a complete reversal of the Examiner's prior rejections in a decision of the Board of Patent Appeals and Interferences. It is Applicants understanding that MPEP §707(g) cautions against the use of piecemeal examination, and furthermore, MPEP §1214.04 notes that after a reversal "[t]he examiner should never regard such a reversal as a challenge to make a new search to uncover other and better references." Applicants feel that the course of prosecution of this Application is in direct contravention to both of these guidelines.

Furthermore, as Applicants will discuss in greater detail below, the position now taken by the Examiner is entirely inconsistent with the findings of the Board in the aforementioned appeal, and as such, the Examiner should be estopped from taking such a position at this point in the prosecution.

Applicants therefore respectfully request that the Examiner withdraw the outstanding art-based rejections and allow the instant application to proceed to issuance.

Now turning specifically to the merits of the Examiner's rejections, all of Applicants claims are generally directed in part to the concept of dynamically prompting a user to select which components, among a plurality of components referenced by a file being downloaded, should be downloaded. Applicants have consistently maintained throughout prosecution, and the Board has likewise agreed, that such components referenced by a file being downloaded do not correspond to hypertext links to other files that may be present in a particular file being downloaded.

Applicants define "components" in the specification as "any item referenced in [an] HTML page to be downloaded and integrated with the page, such as graphics images, background images, audio, video and multimedia files, forms, applets, etc." (Application, page 7, lines 12-15, *emphasis added*). Based upon this definition, a hypertext link defined in a hypertext document, which references a different hypertext

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document that will be retrieved and displayed upon selection of the hypertext link, is not a "component" within the context of Applicants' invention.

This particular interpretation of the term "component" was accepted by the Board of Patent Appeals and Interferences in the Decision dated June 22, 2004. Specifically, the Board favorably cites page 2 of the Specification, which states:

"Many web pages use extensive graphics and other "components" to dress up their web page, where components are defined in this patent to be any additional items referenced in HTML documents. These components are included in an HTML document through the use of specialized tags. For example . . ." (Decision, page 5, *quoting* Application, page 2).

Moreover, the Board indicates that the board considers "components" to be "items referenced in [an] HTML document." Id.

It is also important to note that the Board specifically found the claims to be patentable over U.S. Patent No. 6,044,382 to Martino, which essentially discloses a form-based transaction system where certain forms contain menus that link to other forms (*see*, col. 18, lines 2-22). Upon selection of a menu item on one form, Martino displays another form associated with the menu item. In many ways, the Martino system is analogous to simple conventional hypertext linking, and the Board concluded that this configuration did not disclose or suggest the concept of dynamically prompting a user to select which components, among a plurality of components referenced by a file being downloaded, should be downloaded.

Within this context, Applicants now turn to Bobo II, the reference now asserted by the Examiner to be an anticipatory reference as to all of Applicants independent claims. Bobo II, however, appears to disclose nothing more than conventional hypertext linking - a configuration over which the Board has already found the present claims to be patentable.

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Specifically, the Examiner cites col. 7, lines 25-37 and col. 8, line 53 to col. 9, line 9 for allegedly disclosing dynamically prompting a user to select which of a plurality of components to download. These passages, however, disclose nothing more than conventional HTML hypertext linking. Specifically, the passages describe the display of a web page including a textual listing of facsimile messages, with links or anchors provided to different messages that are displayed in response to user selection of such links.

Bobo II does additionally disclose the ability to display either reduced sized images or full size images of facsimile documents as embedded components of a message list as a form of a preview to enable a user to determine whether they would like to download the full documents (see col. 9, lines 1-37, describing the second to fifth options). It is evident from Bobo II, however, that these images themselves function as hypertext links to other documents, and no prompting is made as to whether or not to download these embedded images themselves.

Put another way, Bobo II discloses at the most the display of a list of messages with one or more preview images of a portion of each message embedded in the list, such that a user can select a preview image to download the complete message. The preview images, however, are always downloaded with the message list, and the user is never "dynamically prompted" in connection with the download of the message list, whether the user would like to download these preview images. Furthermore, the messages that are linked to by the preview images in the message list are separate documents and are not embedded into the message list itself. This conclusion is supported by col. 9, lines 11-14, 27-29, and 33-37, which disclose the downloading of a message in response to selection of a preview image.

Furthermore, col. 8, lines 8-52 of Bobo II disclose how different HTML files are generated and downloaded to display both a message list and the individual messages referenced in the list. In addition, Figs. 4A and 4B, and the accompanying disclosure at

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col. 9, line 38 to col. 10, line 45 (*see, in particular*, the discussion of blocks 112, 120, 130 and 150), disclose that embedded images in a message list include links to the "files" of the messages. Indeed, col. 11, lines 42-43 discloses that, for each message, each page is saved as a separate file.

The Examiner's attention is also directed to Fig. 5, and the accompanying text at col. 10, lines 46-65. In this passage, it is described how Bobo II generates image data for display to a user. In particular, the system apparently extracts a page from a base facsimile file and generates an HTML image. The image is then "embedded with links or anchors to other HTML files." (col. 10, lines 59-61, *emphasis added*).

The Examiner also cites col. 14, lines 1-15 of Bobo II for allegedly disclosing dynamic prompting. Of note, however, this passage in Bobo II is directed to a voice-based system where the "prompting" takes the form of a computerized voice. With all due respect, this passage is completely irrelevant to the claims at issue.

Therefore, it is apparent from a reading of Bobo II that, with regard to the concept of embedded components, the reference discloses nothing more than conventional graphical HTML hypertext links, whereby embedded images may be associated with links to other HTML files such that a user may click on a displayed image to download a different file. However, it is important to note that these embedded images are themselves automatically downloaded along with the HTML page within which they are embedded, and a user is never prompted as to whether or not those embedded images are to be downloaded in connection with the HTML page. The only arguable "prompting" of a user occurs through the display of these embedded images, which results in the retrieval of different HTML files, rather than of those embedded images (which have already been downloaded at that point).

The only manner in which the Examiner could even attempt to argue that Bobo II disclosed or suggested Applicants claims would require that Applicants use of the term "component" covered hypertext links to separate HTML files. As discussed above,

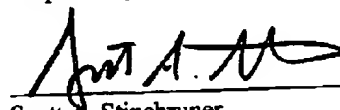
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however, such an interpretation is inconsistent both with the file history and the decision of the Board. The Examiner should therefore be stopped from taking such a position in this case.

As a result, Applicants submit that Bobo II fails to disclose or suggest any of Applicants' claims, which all recite at least in part the concept of dynamically prompting a user to select which components, among a plurality of components referenced by a file being downloaded, should be downloaded. All of claims 38-62 and 65-75 are therefore novel and non-obvious over Bobo II and the other prior art of record. Reconsideration and allowance of all of these claims are therefore respectfully requested.

In summary, Applicants respectfully submit that all pending claims are novel and non-obvious over the prior art of record. Reconsideration and allowance of all pending claims are therefore respectfully requested. If the Examiner has any questions regarding the foregoing, or which might otherwise further this case onto allowance, the Examiner may contact the undersigned at (513) 241-2324. Moreover, if any other charges or credits are necessary to complete this communication, please apply them to Deposit Account 23-3000.

Respectfully submitted,


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